

Appl. No. 09/934,626
Reply to Final Office Action Dated April 28, 2006

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REMARKS

Claims 1-4, 6-15, 17 and 19-22 are pending in the application. Claims 1, 9 and 13 are independent. Applicants respectfully request reconsideration of the present application.

Rejection of Claims

Independent claims 1, 9 and 13 stand rejected under 35 U.S.C. §102(e) being anticipated by Pavley. Applicant respectfully disagrees.

Under 35 USC § 102, a claim is anticipated if, and only if, every element in the claim is expressly or inherently disclosed in a single prior art reference. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. . . [i]nherency, however, may not be established by probabilities or possibilities." *MPEP* § 2112 (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" *Id* (emphasis added). Applicant respectfully submits that Pavley does not disclose, either expressly or inherently, every element of the claimed invention. Accordingly, Pavley does not anticipate.

With respect to claim 1, Pavley does not disclose "disabling image capture." The Office apparently agrees that this feature is not expressly disclosed in Pavley. See Office Action at 2. For example, the Office correctly states "[t]he Examiner generally agrees with Applicant that Pavley does not actually state, 'disabling image capture.'" *Id*. However, the Office appears to contend that "disabling image capture" is necessarily (i.e. inherently) present in the camera disclosed in Pavley. For example, the Office states "Pavley leaves no choice but to disable image capture if the local storage system indicates that more storage space is needed [than is available]." This is untrue.

Pavley discloses the use of rule sets, which are "user-defined routines for achieving a particular goal for an image file." *Col. 5, lines 62-63*. Pavley then goes on to suggest that one such user-defined routine might involve "reclaim[ing] enough storage space to take an image." *Col. 6 lines 2-3*. Pavley further suggest that one may reclaim storage by deleting archived images. Significantly, Pavley never discloses that the only way to reclaim storage

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space is to delete an archived image. The reason Pavley does not state that the only way to reclaim space is to delete an archived image is because one of ordinary skill in the art would recognize that there are numerous ways to reclaim storage space that do not involve deleting an archived image. Accordingly, contrary to what the Office suggests, deleting archived images is not the only possible way of freeing storage space. Thus, a situation where space is needed for a captured image and no archived images are available for deletion does not necessitate the disabling of image capture. Rather, it would be quite simple to conceive of another rule for dealing with this situation. For example, a rule could be created that would delete the oldest non-archived image when more space is needed and no archived images exist. Thus it is not true that "Pavley leaves no choice but to disable image capture."

Accordingly, because Pavley does not disclose all of the features of claim 1, either expressly or inherently, the rejection of claim 1, and the rejections of those claims that depend from claim 1, should be withdrawn.

With respect to independent claim 9 and dependant claims 10-12, which depend from claim 9, the above remarks apply because, similar to claim 1, claim 9 requires "disabling image capture if said memory is full and said memory does not contain any archived images." Therefore, the rejection of claim 9 and the rejection of those claims that depend from claim 9 should be withdrawn.

With respect to independent claim 13 and dependant claims 14-22, which depend from claim 13, the above remarks apply because, similar to claim 1, claim 13 requires "wherein an image capture is disabled if said memory is full and if said memory does not contain at least one archived image." Therefore, the rejection of claim 13 and the rejection of those claims that depend from claim 13 should be withdrawn.

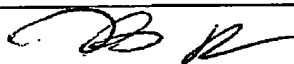
CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be

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withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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